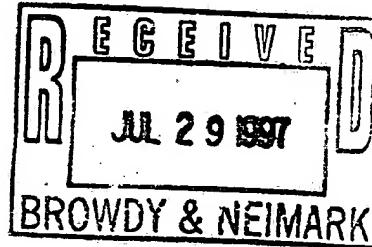




UNITED STATES DEPARTMENT OF COMMERCE  
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Paper No. 12

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In re Application of :  
Haruki Okamura et al. :  
Application No. 08/502,535 :  
Filed: July 14, 1995 :  
For: IFN-UPSILON PRODUCTION :  
INDUCING PROTEIN AND MONOCLONAL :  
ANTIBODY OF THE SAME :  
:

This is a decision on the petition filed April 21, 1997, which is being treated as a petition under 37 CFR 1.182 requesting that the Declaration pursuant to 37 CFR 1.63 filed April 21, 1997 be treated as an original Declaration submitted subsequent to the filing date accorded to this application.<sup>1</sup>

The petition considered under 37 CFR 1.182 is granted.

The application papers deposited on July 14, 1995 included, inter alia, a specification, a preliminary amendment, and a Declaration pursuant to 37 CFR 1.63. The aforementioned Declaration, however, failed to specifically execute the preliminary amendment, as required by 37 CFR 1.63(b)(1). On March 12, 1997 an Office action was mailed, which included, inter alia, an objection to the specification, and a rejection of all the claims on the ground that the (unexecuted) preliminary amendment introduced new matter into the specification and the claims.

The present petition was filed April 21, 1997 seeking relief under, alternatively, 37 CFR 1.181, 1.182, or 1.183. The petition is accompanied by a Declaration under 37 CFR 1.63 which executes the originally deposited papers noted *supra*. The petition considered under 37 CFR 1.181 was denied by the Deputy Group Director in the decision of July 11, 1997.

Petitioners assert that the inventors considered an informal Sequence Listing to be part of the application at the time of

<sup>1</sup> Since there is no requirement or prohibition of the rules of practice to be suspended or waived pursuant to 37 CFR 1.183, 37 CFR 1.182 provides for the question.

execution of the Declaration under 37 CFR 1.63 on June 30, 1995. Petitioners also assert that the Sequence Listing was subsequently modified so as to be in compliance with 37 CFR 1.821 et. seq., and that counsel's intent was to insert the appropriate subject matter into the specification as filed, which was executed by the inventors in the original Declaration, but, through inadvertence, the subject matter was only included in the preliminary amendment, which was not also executed by the original Declaration. Petitioners note that the practice set forth in MPEP 608.04(b) would appear to preclude acceptance of a later filed Declaration that now extends to execution of the preliminary amendment.

It is manifest from the record that the subject matter of the preliminary amendment of July 14, 1995 was received at the PTO on July 14, 1995, and further, that the Declaration also received on that date was defective in that the papers executed by that Declaration did not include the preliminary amendment. Nevertheless, acceptance of the Declaration filed with the petition would not add any subject matter to the specification and claims that was introduced into the record subsequent to the filing date of July 14, 1995. Accordingly, the application will be treated as if the declaration of July 14, 1995 had not been deposited with the other application papers received on that date. Since the preliminary amendment of July 14, 1995 accompanied the original application papers deposited on that date, that amendment, on petition, is reasonably considered to enjoy the status of part of the original disclosure. Cf. MPEP 714.09.

Under the extraordinary circumstances of this application, the declaration filed April 21, 1997 will be treated as an original declaration submitted subsequent to the filing date as set forth in 35 CFR 1.53(d)(1). However, since the declaration of April 21, 1997 is being treated, on petition, as an original declaration submitted subsequent to the filing date, the \$130.00 surcharge set forth in 37 CFR 1.16(e) will be imposed.

Accordingly, the \$130 surcharge for the late filing of the April 21, 1997 Declaration has been charged to Deposit Account No. 02-4035.

The file is being returned to Examining Group 1800 for further action consistent with this decision.

Telephone inquiries pertaining to this decision should be directed to John Chapman at (703) 308-6712, or in his absence, to Brian Hearn at (703) 305-1820.

*Brian Hearn, Jr*  
Abraham Herskovitz,  
Director, Office of Petitions  
Office of the Deputy Assistant Commissioner  
for Patent Policy and Projects